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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,304	11/14/2003	Byung-in Ma	1793.1082	8870
<div>7590 11/14/2007</div> <div>Stein, McEwen &amp; Bui, LLP 1400 Eye Street, N.W. Suite 300 Washington,, DC 20005</div>				
			EXAMINER NGUYEN, LINH THI	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 11/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/712,304

Applicant(s)

MA ET AL.

Examiner

Linh T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 and 28-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The last office action is vacated in favor of this office action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10, 20-22 and 27 are rejected under 35 U.S.C. 102(b) as being unpatentable by Kobayashi (US Patent Number 6097695).

In regards to claims 1 and 20, Kobayashi discloses an apparatus and method for reproducing information from an optical information storage medium which comprises a lead-in area, a user data area, and a lead-out area (Fig. 11), whereon optical information storage medium-related information is recorded in at least a portion of the lead-in area by a first modulation method (bi-phase modulation is used during the first area ADIP; column 5, lines 20-21) and reproduction-related user data are recorded in a portion of remaining area of the optical information storage medium by a second modulation method which is different from the first modulation method (user data DU is modulated (1,7) RLL; Column 14, lines 1-5), the apparatus comprising: a light source which radiates a laser light beam (Fig. 7, element 13); an objective lens which condenses the laser light beam to be focused on the optical information storage medium (Column 7, lines 13-15); a photodetector which receives the laser light beam

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reflected from the optical information storage medium and which comprises first and second photodiodes which independently convert a received optical signal into first and second electric signals (Column 7, lines 49-61), respectively; a reproduction-related user (RRU) data demodulator which demodulates the reproduction-related user data from a sum signal of the first and second electrical signals (Column 8, lines 8-19); and a read only memory-permanent information control (ROM-PIC) data demodulator which demodulates the optical information storage medium-related information from the sum signal (Fig. 6, ADIP data are read only information); .

In regards to claims 2 and 21, Kobayashi discloses the optical information reproducing apparatus and method, wherein: the RRU data (user data DU) demodulator reproduces the reproduction-related user data which is recorded on the optical information storage medium according to a run length-limited (RLL) modulation method (Column 13, lines 31-39), and the ROM-PIC data (ADIP data are read only data) demodulator reproduces the optical information storage medium-related information which is recorded on the optical information storage medium according to a bi-phase modulation method (Column 15, lines 19-20).

In regards to claims 3 and 22, Kobayashi discloses the optical information reproducing apparatus and method, wherein the RLL modulation method is an RLL (1, 7) modulation method (Column 14, lines 1-7).

In regards to claims 10 and 27, Kobayashi discloses the optical information reproducing apparatus and method, further comprising a modulation code detector which detects from the sum signal whether the optical information storage medium comprises a plurality of different modulation codes (Fig. 3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent number 6097695).

In regards to claim 4-9 and 23-26, Kobayashi discloses everything that is claimed in claim 1 above. However, Kobayashi does not disclose the RLL modulation method is an RLL (1, 7) modulation method, information recorded according to the bi-phase modulation method comprises marks and spaces having length of  $nT$ , and marks and spaces having length of  $2nT$ , wherein  $n$  is within a range of  $2 \leq n \leq 8$ , the RLL modulation method is an RLL (2, 10) modulation method, and information recorded according to the bi-phase modulation method comprises marks and spaces having a length of  $nT$ , and marks and spaces having a length of  $2nT$ , wherein  $n$  is within a range of  $2 \leq n \leq 8$ .

It would have been obvious to a one having ordinary skills in the art at the time of the invention was made to have the data is recorded as the pit wobble is bi-phase

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modulation method, and the second data recording modulation method used in the remaining area in which the data is recorded as the pits an RLL modulation method, the RLL modulation method is an RLL (1, 7) modulation method, information recorded according to the bi-phase modulation method comprised marks and spaces having length of  $nT$ , and marks and spaces having length of  $2nT$ , wherein  $n$  is within a range of  $2 \leq n \leq 8$ , the RLL modulation method is an RLL (2, 10) modulation method, and information recorded according to the bi-phase modulation method comprises marks and spaces having a length of  $nT$ , and marks and spaces having a length of  $2nT$ , wherein  $n$  is within a range of  $2 \leq n \leq 8$ .

The motivation would have been optimization/experimentation in the course of routine engineering. Moreover, absent a showing of criticality, i.e., unobvious or unexpected results, the relationships set forth in claims 4-9 and 23-26 are considered to be within the level of ordinary skill in the art.

Additionally, the law is replete with cases in which the mere difference between the claimed invention and the prior art is some range, variable or other dimensional limitation within the claims, patentability cannot be found.

It is furthermore has been held in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range (s): see *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Moreover, the instant disclosure does not set forth evidence ascribing unexpected results due to the claimed dimensions; see *Gardner v. TEC Systems, Inc.*,

725 F.2d 1338 (Fed. Cir. 1984), which held that the dimensional limitations failed to point out a feature which performed and operated any differently from the prior art.

### ***Response to Arguments***

Applicant's arguments filed 08/16/07 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "whereon optical information storage medium-related information is recorded in at least a portion of the lead-in area but not in the user data area" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37.CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh T. Nguyen whose telephone number is 571-272-5513. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LN

October 22, 2007

WAYNE YOUNG  
SUPERVISORY PATENT EXAMINER